

09/699,961

MS150612.01/MSFTP140US

REMARKS

Claims 1, 3-7, 18-20, 22, and 31-42 are currently pending in the subject application and are presently under consideration. Claims 2, 8-17, 21, 23-30, 32, and 36 have been canceled, and applicant's representative intends to pursue these claims in a divisional application. Claims 38-42 are withdrawn, however, applicant's representative reserves the right to seek rejoinder of such non-elected claims upon allowance of the claims. In addition, claims 1, 3, 18, 31, and 33 have been amended herein to clarify what applicant regards as the invention – such amendments are not intended to limit the scope of the claimed invention. A version of all pending claims is found at pages 2-5.

Additionally, claims 1, 3-7, 18-20, 22, 31, 33-35, and 37 stand rejected in the Advisory Action dated February 4, 2005. According to the comments and amendments made herein, applicant's representative respectfully requests a withdrawal of this rejection.

I. Rejection of Claims 1-2, 5-7, and 31-37 Under 35 U.S.C. §102(e)

In the the Final Office Action dated August 24, 2004, claims 1-2, 5-7, and 31-37 stand rejected under 35 U.S.C. §102(e) as being anticipated by Spiegel *et al.* (US 6,629,079 B1). It is respectfully submitted that Spiegel *et al.* fails as an anticipatory reference for at least the following reason. Spiegel *et al.* neither teaches nor suggests each and every limitation of the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Specifically, the subject invention allows for a single electronic shopping component to have an association with a plurality of different sources. Thus, for example, the user only needs to employ one shopping basket to *concurrently effect transactions with multiple entities*. In particular, independent claims 1, as amended, recite an *ordering component providing for*

09/699,961

MS150612.01/MSFTP140US

concurrent ordering of at least two of the identified items from the different sources.

Independent claims 18, 31, and 33 similarly recite such a novel aspect.

Spiegel *et al.* does not teach or suggest ***concurrent ordering of items from different sources***. Rather, the cited reference discloses the use of multiple shopping baskets associated with a *single, common source*. (See col. 3, ln. 18-19). The multiple shopping baskets can be associated with unique roles/contexts of a user, thereby facilitating organization of shopping events associated with the *common source*. More particularly, each shopping cart is intended to be used when a user is purchasing items from a common source in different respective roles (e.g. work and personal use). (See col. 4, ln. 6-12). Hence, a user during a single shopping experience can employ multiple carts where each shopping cart has associated with it appropriate billing and shipment information related to a particular role. (See col. 4, ln. 16-22).

Moreover, the very notion of employing multiple carts further supports that Spiegel *et al.* interacts with a *single source* since the purpose of using multiple carts is to differentiate various roles of a user within a shopping experience with a single source. For example, the cited reference discloses that a user can use multiple carts (each with different shipping addresses) to effect purchasing and deliver of gifts to different individuals. (See col. 4, lines 40-50). Yet, there is no mention anywhere in the cited reference of using a single cart in connection with ***purchasing items from a plurality of different sources*** as in applicant's claimed invention. Thus, it is readily apparent that Spiegel *et al.* does not teach or suggest allowing a user to ***concurrently order*** items from different sources as in applicant's claimed invention.

In view of at least the forgoing, it is respectfully submitted that Spiegel *et al.* does not teach or suggest applicant's invention as recited in the subject claims, and a rejection under §102(e) will not be successful in light of the current amendments to the subject claims.

II. Rejection of Claims 3-4 Under 35 U.S.C. §103(a)

In the Final Office Action dated August 24, 2004, claims 3-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Spiegel *et al.* and further in view of Call (US 6,154,738). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Spiegel *et al.* nor Call, individually and in combination, teach or suggest all the limitations as recited in the subject claims.

09/699,961

MS150612.01/MSFTP140US

Claims 3-4 depend from independent claim 1 and Call fails to make up for the aforementioned deficiencies of Spiegel *et al.* regarding this independent claim. Call is simply directed to methods and an apparatus for disseminating over the Internet product information using product codes as access keys. Accordingly, applicant's claimed invention is not obvious over the combination of these references; and this rejection would not be successful as claims 3-4 depend from amended independent claim 1.

III. Rejection of Claims 18-22 Under 35 U.S.C. §103(a)

In the Final Office Action dated August 24, 2004, claims 18-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Call (US 6,154,738) and further in view of Spiegel *et al.* It is respectfully submitted that Call fails as a reference for an obviousness rejection for at least the following reason. Neither Spiegel *et al.* nor Call, individually and in combination, teach or suggest all the limitations as recited in the subject claims.

"Under 35 U.S.C. 103 where the examiner has relied on the teachings of several references, the test is *whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art.* It is to be noted, however, that citing references which merely indicated that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the references in such a manner as to arrive at the claimed invention... [I]t would not have been obvious to modify [the prior art] ... without using [the patent application's] claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." *Ex parte Hiyamizu*, 10 USPQ2d 1393 (BPAI 1988).

Call discloses allowing a user to click on Internet links to product information, where the activated link sends a request message containing at least a portion of a universal product code via the Internet to a cross-referencing database. (*See* col. 2, ln. 15-21) The database then returns the *Internet address* of the particular manufacturer's server which then makes the desired product information available. (*See* col. 2, ln. 23-25) Thus, Call discloses utilizing universal

09/699,961

MS150612.01/MSFTP140US

product codes and a database to obtain the *location of product information on the Internet*. (See Abstract) However, Call does not teach or suggest *providing concurrent ordering of items from disparate sources*, as recited in amended independent claims 1, 18, 31, and 33 of applicant's invention.

In view of at least the above, it is respectfully submitted that Call neither teaches nor suggests each and every limitation of applicant's invention. Accordingly, a §103(a) rejection based on a combination of Call in view of Spiegel *et al.* would not be successful as against the current amendments recited in the subject claims.

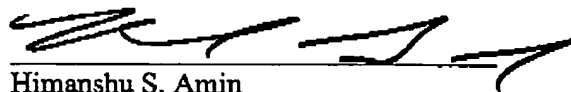
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited. In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTPP140US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731